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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

AGUSTIN, PETER VINCENT

ART UNIT	PAPER NUMBER
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2627

DATE MAILED: 06/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/916,292

Applicant(s)

OHGAKE, MITSURU

Examiner

P. Agustin

Art Unit

2627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-11 and 17-20 is/are allowed.
- 6) ☒ Claim(s) 1-7, 12-16 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-21 are now pending.

Specification

2. The amendment filed April 20, 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the amendment to claims 2 & 13, as noted in the 112-1st paragraph rejection below.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Objections

3. Claims 2 & 13 are objected to because of the following informalities:

Claim 2, step (c), as currently amended, recites "storing said strategy information, said strategy information corresponding to device information of said recording and reading device, and medium information of an optical recording medium to said strategy information storing part". The placement of commas in the amendment suggests that the claimed "strategy information" and "medium information" are two separate elements, both of which are stored in the claimed "strategy information storing part". However, as originally disclosed by the Applicant in Figure 4, step S11, the strategy information corresponds to both the "device information" and "medium information" (see also the third column of Figure 2, and claim 2 as originally filed). There is no disclosure or suggestion of these two elements as being separate. The Examiner suggests amending step (c) as --storing said strategy information, said strategy

information corresponding to device information of said recording and reading device and medium information of an optical recording medium, to said strategy information storing part--.

Note that claim 13 has similar limitations as claim 2.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 2-5 & 13-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 2, step (c), as currently amended, recites “storing said strategy information, said strategy information corresponding to device information of said recording and reading device, and medium information of an optical recording medium to said strategy information storing part”. On page 14, paragraph 2 of the Applicant’s remarks, it is submitted that “strategy information” and “medium information” are separate elements, and the claims have been amended to clarify the distinction. However, as originally disclosed by the Applicant in Figure 4, step S11, the strategy information corresponds to both the “device information” and “medium information” (see also the third column of Figure 2, and claim 2 as originally filed). There is no disclosure or suggestion of these two elements as being separate, as stated by the Applicant. The

Examiner suggests amending step (c) as --storing said strategy information, said strategy information corresponding to device information of said recording and reading device and medium information of an optical recording medium, to said strategy information storing part--.

Claim 13 has similar limitations as claim 2.

Claims 3-5 & 14-16 are dependent upon rejected base claims.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-7, 12-16 & 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakajo (US 5,502,702).

In regard to claim 1, Nakajo discloses a method for optically recording information in a system (Figure 1) comprising a recording and reading device (14, 16, 18, 22 & 26) that includes a first controller (26) and a strategy part (16 & 18) for conducting a strategy when optically recording information and an information processing apparatus (20 & 26) that includes a second controller (26) and a strategy information storing part (20) storing the strategy information for operating said strategy part (16 & 18), said method comprising the steps of: (a) reading said strategy information for operating said strategy part of said recording and reading device from said strategy information storing part of said information processing apparatus with said second controller (column 5, lines 37-45); and (b) transmitting said strategy information read in said step (a) to said recording and reading device (column 5, lines 37-45).

In regard to claim 2, Nakajo discloses the steps of: (c) storing said strategy information, said strategy information corresponding to device information of said recording and reading device, and medium information of an optical recording medium to said strategy information storing part (column 5, lines 30-34; see also column 1, lines 17-28, which teach that recording power differs depending upon the type of dyestuff on a disc, and write strategy needs to be adjusted accordingly); (d) transmitting the device information and the medium information from said recording and reading device to said information processing apparatus (column 5, lines 37-45); (e) reading said strategy information corresponding to said device information and medium information from said strategy information storing part in said information processing apparatus (column 5, lines 37-45); and (f) transmitting said strategy information with said medium information to said recording and reading device (column 5, lines 37-45).

In regard to claim 3, Nakajo discloses the steps of: (g) storing standard strategy information to said strategy information storing part (column 7, lines 26-35: "basic control information"); (h) reading said standard strategy information and transferring said standard strategy information to said recording and reading apparatus when the strategy information corresponding to the device information and the medium information transmitted from said recording and reading device is not stored in said strategy information storing part (column 7, lines 32-35).

In regard to claim 4, Nakajo discloses that said medium information is read and obtained from the optical recording medium (column 5, lines 35-45).

In regard to claim 5, Nakajo discloses that said step (h) cancels transmitting said device information and said medium information to said information processing apparatus when said

medium information additionally provided to said strategy information stored in said strategy part corresponds to said medium information of said optical recording medium, and activates said strategy part to record to the optical recording medium (understood from column 7, lines 26-35).

In regard to claim 6, Nakajo discloses that a plurality of data sets of the strategy information is stored in said strategy part (column 5, lines 43-45).

In regard to claim 7, Nakajo discloses that said step (b) is conducted just before starting recording information to said optical recording medium (column 5, lines 40-42).

In regard to claim 12, Nakajo discloses a computer-readable recording medium (Figure 1, element 10) recorded with program code for causing a computer (B & C) to optically record information in a system comprising a recording and reading device (14, 16, 18, 22 & 26) that includes a first controller (26) and a strategy part (16 & 18) for conducting a strategy when optically recording information and an information processing apparatus (20 & 26) that includes a second controller (26) and a strategy information storing part (20) storing the strategy information for operating said strategy part (16 & 18), said program comprising the codes for: (a) reading said strategy information for operating said strategy part of said recording and reading device from said strategy information storing part of said information processing apparatus with said second controller (column 5, lines 37-45); and (b) transmitting said strategy information read by said code (a) to said recording and reading device (column 5, lines 37-45).

Claims 13-16 have limitations similar to those of claims 2-5; thus, they are rejected on the same basis.

In regard to claim 21, Nakajo discloses a method for optically recording information in a system (Figure 1) comprising (1) a recording and reading device (14, 16, 18, 22 & 26) that includes a first controller (26) and a strategy part (16 & 18) for storing and conducting a strategy when optically recording information and (2) an information processing apparatus (20 & 26) that includes a second controller (26) and a strategy information storing part (20) storing the strategy information for operating said strategy part (16 & 18), said method comprising the steps of: (a) reading said strategy information for operating said strategy part of said recording and reading device from said strategy information storing part of said information processing apparatus with said second controller (column 5, lines 37-45); and (b) transmitting said strategy information read in said step (a) to said recording and reading device and storing said strategy information in said strategy part (column 5, lines 37-45).

Allowable Subject Matter

8. Claims 8-11 & 17-20 are allowed over the prior art of record.

Response to Arguments

9. Applicant's arguments, see page 13, paragraph 5 thru page 14, paragraph 1, filed April 20, 2006, with respect to the rejection of claims 1-7, 12-16, and 21 under 35 U.S.C. § 112, second paragraph as being incomplete for omitting essential structural cooperative relationships of elements, have been fully considered and are persuasive. Therefore, this rejection has been withdrawn.

10. Applicant's arguments filed April 20, 2006 have been fully considered but they are not persuasive.

- a. In response to Applicant's argument on page 14, paragraph 2, the rejection of claims 2-5 & 13-16 under 35 U.S.C. § 112, second paragraph as being indefinite have been withdrawn in light of the amendment to claims 2 & 13 and the Applicant's clarification that "strategy information" and "medium information" are separate elements. It should be noted, however, that these claims are now rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. As originally disclosed by the Applicant in Figure 4, step S11, the strategy information corresponds to both the "device information" and "medium information" (see also the third column of Figure 2, and claim 2 as originally filed). There is no disclosure or suggestion of these two elements as being separate, as stated by the Applicant.
- b. In response to Applicant's arguments on page 14, last paragraph that "Nakajo discloses only a single recording control circuit 26" and "there is no second controller", it should be noted that element 26 is read to correspond to both the claimed "first controller" and "second controller". There is no requirement that these two be separately provided. Furthermore, a mere "duplication" of a controller has no patentable significance unless a new and unexpected result is produced. See *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2627


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Agustin whose telephone number is 571-272-7567. The examiner can normally be reached on Monday-Friday 9:30-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, A. L. Wellington can be reached on 571-272-4483. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

P. Agustin
Art Unit 2627



Brian Miller
Primary Examiner
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